

REMARKS/ARGUMENTS

The Office Action dated October 21, 2003 has been received and its contents carefully considered. Claims 6-11, 14 and 16 are pending. Claims 6-11, 14 and 16 have been rejected. Claims 6, 14 and 16 have been amended. New claims 17 and 18 have been added.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 6-11, 14-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Hagen, et al.* Without conceding the propriety of the rejection, independent claims 6, 14 and 16 have been amended. It is respectfully submitted that *Hagen, et al* does not teach, *inter alia*, an apparatus for adding functionality to a portable electronic device comprising “a hardware interface connector connected to a hardware interface port of the portable electronic device, said hardware interface connector and said hardware interface port positioned within the interior portion of the housing” as recited in claim 6. Furthermore, it is respectfully submitted that *Hagen et al* does not teach, *inter alia*, a method of adding functionality to a portable electronic device comprising “attaching a hardware interface connector within the interface portion of the housing; connecting the hardware interface port of the portable electronic device to the hardware interface connector within the interior portion of the housing” as recited in claim 14. Additionally, it is respectfully submitted that *Hagen et al* does not teach, *inter alia*, a device for adding functionality to a portable electronic device comprising “a means for connecting a hardware interface connector to a hardware interface port of the portable electronic device within the interior portion of the housing” as recited in claim 16.

Hagen et al merely discloses a portable system for programming hearing aids. A PCMCIA port 18 of a host computer 10 is configured to receive a PCMCIA card 40 in order to receive a hearing aid program from the host computer 10. As noted by the Examiner in the previous Office Action under the *RESPONSE TO ARGUMENTS*, the Examiner has not considered the “contacts themselves being within the housing.” Specifically, the Examiner discloses that “*Hagen et al* discloses the context being accessible from the exterior of the housing,” as opposed to an interior as claimed by the present invention. Thus, *Hagen et al* teaches away from the present invention as claimed.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 f.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Since each and every element of the present invention is not taught by the prior art, *Hagen et al* cannot teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 7-11 ultimately depend from independent claim 6 and are patentable over the cited art for at least the same reasons as is claim 6.

Newly added claim 17 recites similar features as claimed in claims 6, 14, and 16. It is respectfully submitted that *Hagen et al* does not teach, *inter alia*, an apparatus comprising a “hardware interface connector and said hardware inter face port positioned within the interior portion of the housing” as recited in claim 17. Since each and every element of the present invention is not taught by the prior art, *Hagen et al* cannot teach the present invention as claimed.

Docket No. 87355.1721
Application No. 09/702,750
Customer No. 30734

Patent

Newly added claim 18 depends from independent claim 16 and is patentable over the cited prior art for at least the same reasons as is claim 16.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a stylized, flowing script.

Marc W. Butler
Reg. No. 50,219

Date: May 4, 2004
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1500
Facsimile: 202-861-1783